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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,159	06/25/2003	Andrew Chau	200209360-1	5611

22879 7590 10/05/2005

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EXAMINER

CHUNG, PHUNG M

ART UNIT PAPER NUMBER

2133

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/607,159

Applicant(s)

CHAU ET.AL.

Examiner

Phung My Chung

Art Unit

2133

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/19/05</u> . | 6) <input type="checkbox"/> Other: ____  |

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jarwala et al (EP 0662616) in view of the applicant admitted prior art (hereafter AAPA).

As per claims 1 and 8, Jarwala et al teach a system for testing device, comprising:

a first device and

a signal selector (MUX 38) for selecting between an output signal that is output from the first device and a bypass signal that has bypassed the first device. (See abstract, Fig. 2, col. 5, lines 50-58 to col. 6, lines 1-25). Jarwala et al do not disclose a second device for test coupled to the first device in a scan chain. However, the AAPA does disclose decices under test can be coupled in series in what is referred to as a scan chain (pg. 1, lines 23-25). Therefore, it would

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have been obvious to a person of ordinary skill in the art, at the time the invention was made, to set a second test device connected to the first device in a scan chain as taught by the AAPA into the invention of Jarwala et al to allow the testing a other devices in a scan chain without unnecessray overhead (pg. 1, lines 24-25).

As per claim 2, wherein the signal selector is coupled to a first power rail that is also coupled to the first device is inherent in system of Jarwala et al.

As per claims 3 and 4, Jarwala et al further disclose wherein the signal selector selects the bypass signal when the first power rail is low and the output signal when the first power rail is high (col. 6, lines 4-54 and col. 8, lines 48-58 to col. 9, lines 1-14).

As per claim 5, Jarwala et al further disclose wherein the signal selector selects between the output signal and the bypass signal in response to a control signal (col. 6, lines 13-17).

As per claim 6, this claim is rejected under similar rationale as set forth in claim 2.

As per claim 7, Jarwala et al further disclose wherein the signal selector is a multiplexer (36).

As per claims 9, 14-15 and 23, these claims are rejected under similar rationale as set forth in claims 1 and 8.

As per claims 10 and 16, these claims are rejected under similar rationale as set forth in claim 2.

As per claims 11-12 and 17-18, these claims are rejected under similar rationale as set forth in claims 3-4.

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As per claims 13 and 19, these claims are rejected under similar rationale as set forth in claim 5.

As per claims 20 and 21, these claims are rejected under similar rationale as set forth in claim 6.

As per claim 22, this claim is rejected under similar rationale as set forth in claim 7.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phung My Chung whose telephone number is 571-272-3818. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on 571- 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Phung My Chung  
Primary Patent Examiner